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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,240	12/05/2001	James G. Shanahan	D/A1320Q1	8313

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/683,240

Applicant(s)

SHANAHAN ET AL.

Examiner

Joshua D Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/9/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 12/05/2001 and IDS filed on 03/09/2002.
2. Claims 1-20 are pending in the case. Claims 1, 10, and 19 are independent claims.

### ***Drawings***

3. The drawings were received on 12/05/2001. These drawings are accepted.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6, 10-15, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. (hereinafter Horowitz, US Patent Number 6,122,647, issued on September 19, 2000) in view of Goodisman et al. (hereinafter Goodisman, US Patent Application Publication Number 2002/0069223, US filing date of November 17, 2000).

**Regarding independent claim 1**, Horowitz discloses a method in which a request is received from a client interface for a document service, which includes at least one document property and one enrichment property (column 5, lines 56-64 and column 9, lines 1-63 of Horowitz). The document property defines document content, while the enrichment property defines a personality identifier (column 5, lines 56-64 and column 9, lines 1-63 of Horowitz). The electronic document content is then enriched at the server based on the personality (theme) identified by the personality identifier (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Horowitz does not disclose explicitly that the enrichment property is a part of the initial request. However, Goodisman discloses a method in which the reading device automatically defines a personality that is associated with a personality identifier (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claim 2**, Horowitz discloses a method in which the service is carried out with the enriched document content (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz).

**Regarding dependent claims 3 and 4**, Horowitz discloses a method in which a particular portion of a document is defined by the property, which would include a document capture point (i.e. starting point) (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz).

**Regarding dependent claim 5**, Horowitz discloses a method in which a personality identifier is associated with identified document content (Figure 8 and column 10, lines 4-45 of Horowitz). An entity in the document content is recognized and a document service is accessed using the recognized entity (column 8, lines 39-61 and column 9, lines 28-63 of Horowitz). The identified document content is then annotated with output from the document service to define enriched content, at which point the content is made available to the users (column 10, lines 4-45 and column 11, lines 39-52 of Horowitz).

**Regarding dependent claim 6**, Horowitz does not disclose a method in which one enrichment property at the client interface is used to define a form in which the content is to be annotated. However, Goodisman discloses a method in which an enrichment property (i.e. time and location of mobile device) is used to define a form in which to annotate the content (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and

Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding independent claim 10 and dependent claims 11-15**, the claims incorporate substantially similar subject matter as claims 1-6. Thus, the claims are rejected along the same rationale as claims 1-6.

**Regarding independent claim 19 and dependent claim 20**, the claims incorporate substantially similar subject matter as claims 1 and 5. Thus, the claims are rejected along the same rationale as claims 1 and 5.

7. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. (hereinafter Horowitz, US Patent Number 6,122,647, issued on September 19, 2000) in view of Goodisman et al. (hereinafter Goodisman, US Patent Application Publication Number 2002/0069223, US filing date of November 17, 2000) as applied to claims 1 and 10 above, and further in view of Keith JR (hereinafter Keith, US Patent Application Publication Number 2002/0032672, US filing date of March 9, 2000).

**Regarding dependent claims 7 and 16**, neither Horowitz nor Goodisman explicitly disclose notifying the user when document enrichment is complete. However, Keith discloses a method in which a user is notified when data of a document has completed an update (Pages 10-11, paragraphs 0092-0094 of Keith). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman with the methods of Keith

because it would have allowed users to see desired information as soon as it was updated with the enriched content.

8. Claims 8, 9, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. (hereinafter Horowitz, US Patent Number 6,122,647, issued on September 19, 2000) in view of Goodisman et al. (hereinafter Goodisman, US Patent Application Publication Number 2002/0069223, US filing date of November 17, 2000) as applied to claims 1 and 10 above, and further in view of Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000).

**Regarding dependent claims 8, 9, 17, and 18**, neither Horowitz nor Goodisman explicitly disclose a method of using personality buttons, wherein the personality buttons form part of the user interface to one of a scanner, a Dictaphone, a video camera and a printer. However, Nehab discloses a method in which a personality (personal preferences profile) is based on the buttons of the interface (personality buttons), which provide part of the user interface to a printer (Figure 9A and column 10, lines 6-20 of Nehab). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman with the methods of Nehab because it would have allowed an simpler way to interact their personality preferences with a printer.

### ***Conclusion***

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,185,592

US Patent Number 6,651,058

US Patent Number 6,667,747

US Patent Number 6,711,585

US Patent Number 6,753,977

US Patent Application Publication Number 2002/0026297

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
February 25, 2005

  
HEATHER R. HERNDON  
SUPERVISORY PATENT EXAMINER  
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